Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. GRUNDY
and
MICHAEL PEARSON

Appeal No. 2001-0122
Application No. 09/040,911

ON BRIEF

Before KIMLIN, PAK, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

REMAND PURSUANT TO 37 CFR § 1.196(a)(1997)

On consideration of the record, we determine that the above-identified application is not ready for a decision on appeal under 35 U.S.C. § 134 (2002). Accordingly, we remand this application to the examiner for further action and consideration not inconsistent with our opinion below and not inconsistent with current patent practice and procedure.

Claims 1 through 17 on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over: (i) PCT Application WO

Application 96/23855 of Dillworth et al. (Dillworth); or (iii) U.S. Patent 5,833,721 issued to Hart et al. (Hart) on Nov. 10, 1998. (See the examiner's answer of May 8, 2000, paper 12, page 3, which refers to the Office action of Dec. 18, 1998, paper 5, page 2.)

In an effort to rebut any possible prima facie case of obviousness, the appellants have presented detailed arguments in support of nonobviousness based on evidence already in the record. (Appeal brief, pages 10-13.) Specifically, the appellants rely on the experimental data found in the specification, namely the working examples and the associated data summarized in Tables 3-5. (Specification, pages 12-27.)

The examiner, on the other hand, responds as follows (answer, page 5):

> [T]he Examiner have [sic] reviewed and reconsidered the Experimental data of record relied on as showings of the results presented therein to rebut the prior art of record [sic]. The Examiner maintains the position stated in the final Office action paper No. 9 that Appellants have not drafted the claims in a manner to be within the scope argumented [sic] and supported by the Experimental data of record in the instant Application because the drafted claims do not exclude the teachings of the relied on prior art (5,833,721) used in the art rejection of record. It is noted that arguments unsupported by factual evidence do not take the place of objective evidence of

evidence do not take the place of objective evidence of unobviousness.[1]

We, like the appellants, have difficulty understanding the examiner's position. In particular, we are unclear what the examiner means by the statement "Appellants have not drafted the claims in a manner to be within the scope argumented [sic] and supported by the Experimental data of record in the instant Application because the drafted claims do not exclude the teachings of the relied on prior art (5,833,721) used in the art rejection of record." (Emphasis added.) Is the examiner alleging that Hart anticipates the appealed claims? Also, contrary to the examiner's holding, the appellants' arguments in the appeal brief at pages 10 through 13 are in fact supported by objective evidence.

Upon return of this application, the examiner should fully reevaluate the relied upon evidence and provide a detailed,

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[1] Like the answer, the final Office action states (pp. 2-3):

> Applicants' arguments have been reviewed and considered but arguments unsupported by factual evidence do not take the place of objective evidence of unobviousness. Applicants have not drafted the claims in a manner to be within the scope argumented [sic] and supported by the experimental data of record relied on showing the results presented therein. The claims as drafted do not exclude the teachings of WO/9/10593 [sic] or WO 96/23855 or Hart et al (5,833,721).

reasoned analysis on why the proffered evidence is insufficient to overcome the asserted prima facie case of obviousness, so as to afford the appellants with a fair opportunity to respond to the examiner's criticisms.

We emphasize that this remand, which is ordered pursuant to 37 CFR § 1.196(a), does not authorize a supplemental examiner's answer as in 37 CFR § 1.193(b)(1)(2000), which is concerned with unanswered reply briefs.

This application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01(D)(8th ed., Aug. 2001). Thus, it is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED

Edward C. Kimlin)
Administrative Patent Judge)
)
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)
Chung K. Pak) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
Romulo H. Delmendo)
Administrative Patent Judge)

RHD/gjh

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Application Serial Number 09/040911

	DATE	INITIALS
Mail Personnel		
Receive case and PALM in	10-11-00	KVC
Docket Personnel I		
OB/Heard Classification	10-18-00	SS
Outline case		
Reviewers		
Review/assign panel	12/19/01	
Prepare order/remand		
Docket Personnel I		
Enter data in ACTS/PALM	1/24/01	KS
Prep case (if panel assigned)		
Docket Personnel I		
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Administrators		
Assign Hearing Date		
Docket Personnel II		
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DESIGNATION OF PANEL

Pursuant to (1) the Commissioner's authority to designate the members of the Board of Patent Appeals and Interferences to hear cases before the Board (35 U.S.C. 7(b)), and (2) Commissioner Lehman's memorandum dated May 1, 1994 (delegating to the Chief Administrative Patent Judge the responsibility of designating members to hear cases before the Board), it is ORDERED that the panel of the Board of Patent Appeals and Interferences designated to hear this case shall consist of the following members of the Board:

☒ On Brief ☐ Heard ☐ Redesignation ☐ Expanded Panel, see addendum.

1. Judge Delmendo
2. Judge Kimlin RD 8/13/02
3. Judge Pak

Bruce H. Stoner, Jr.

BRUCE H. STONER, JR.
Chief Administrative Patent Judge

Date of Hearing: _____